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09/807,499	11/05/2001	Christian Rosenmund	VOSS1160	9348

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EXAMINER

MURPHY, JOSEPH F

ART UNIT PAPER NUMBER

1646

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/807,499

**Applicant(s)**

CHRISTIAN ROSENMUND

**Examiner**

Joseph F. Murphy

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 and 24-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21-23, 34-35, 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

T.P

## **DETAILED ACTION**

### ***Formal Matters***

Claims 1-35, 37 are pending. Claims 18-20, 24-33 stand withdrawn from consideration pursuant to 37 CFR 1.142(b). Claims 1-17, 21-23, 34-35, 37 are under consideration.

### ***Response to Amendment***

The rejection of claims 10-16 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 34-35 under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 10-16 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a host cell in culture comprising a polynucleotide with the sequence as set forth in SEQ ID NO: 17, does not reasonably provide enablement for in vivo transfection, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 34-35 under 35 USC 112 second paragraph which provides for the use of the nucleic acid of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to cover, has been obviated by Applicant's amendment and is thus withdrawn.

The rejection of claim 2 under 35 U.S.C. 102(b) as being anticipated by Stratagene (1991), has been obviated by Applicant's amendment adding the limitation wherein the

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nucleotide is 12 nucleotides long, and is thus withdrawn. This rejection will be reinstated if the limitation is removed due to the rejection under 35 USC 112 first paragraph for the addition of new matter, *supra*.

New and remaining issues are set forth below.

### ***Claim Objections***

Claims 1-4, 17, 21, 37 are objected to because of the following informalities: The claims recite the term "polypeptide" as "(poly)peptide". It is not clear why the prefix is encased as a parenthetical, but it is not necessary, as the term "polypeptide" is obviously well known in the art, whereas the construction (poly)peptide is not common. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112 first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the invention as now claimed: an nucleic acid molecule having at least 12 nucleotides.

Applicant's amendment, submitted 5/12/2005, does not provide sufficient direction for the written description for the above mentioned limitations of claim 2. The specification as filed does not provide a written description or set forth the metes and bounds of this phrase. The specification does not provide direction for the instant sequence encompassing the above-

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mentioned "limitations" as they are currently recited. The instant claims now recite limitations which were not clearly disclosed in the specification as-filed, and now change the scope of the instant disclosure as-filed. Such limitations recited in the present claims, which did not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112.

Applicant is required to cancel the new matter in the response to this Office action

Alternatively, applicant is invited to provide sufficient written support for the "limitations" indicated above.

***Claim Rejections - 35 USC § 112 first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17, 21-23, 34-35, 37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, which is enabling for a nucleic acid encoding a full length AMPA Receptor protein of SEQ ID NO: 7, or a nucleic acid of SEQ ID NO: 17, does not reasonably provide enablement for a complement of a nucleic acid which hybridizes to a nucleic acid encoding SEQ ID NO: 7; or a nucleic acid which encodes SEQ ID NO: 7 and further comprising amino acid additions substitutions or deletions; or a nucleic acid which encodes an AMPA-type receptor and further comprising amino acid additions substitutions or deletions, or a nucleic acid encoding a polypeptide having at least 70% identity to SEQ ID NO: 7, for reasons of record as set forth in the Office Action of 1/10/2005. The specification does not enable any person skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The rejection of record set forth that claims 1-17, 21-23, 34-35, 37 are overly broad since insufficient guidance is provided as to which of the myriad of nucleic acids encode variant polypeptides which will retain the characteristics of AMPA Receptor. However, Applicants do not disclose any actual or prophetic examples on expected performance parameters of any of the possible muteins of AMPA Receptor. It is known in the art that even single amino acid changes or differences in the amino acid sequence of a protein can have dramatic effects on the protein's function. Since the claims encompass nucleic acids encoding variant polypeptides and given the art recognized unpredictability of the effect of mutations on protein function, it would require undue experimentation to make and use the claimed invention. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. While the Specification discloses that the encoded polypeptide functions in the chondrocyte re-differentiation assay, the claims do not set forth a functional limitation for the nucleic acids encoding the variant polypeptides and since the amino acid sequence of a polypeptide determines its structural and functional properties, and the predictability of which amino acids can be substituted is extremely complex and outside the realm of routine experimentation, because accurate predictions of a polypeptide's structure from mere sequence data are limited. Since detailed information regarding the structural and functional requirements of the polynucleotide and the encoded polypeptide are lacking, it is unpredictable as to which variations, if any, meet the limitations of the claims. Applicant is required to enable one of skill in the art to make and use the claimed invention, while the claims

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encompass polynucleotides and encoded polypeptides which the specification only teaches one skilled in the art to test for functional variants. It would require undue experimentation for one of skill in the art to make and use the claimed polypeptides. Since the claims do not enable one of skill in the art to make and use the claimed polypeptides, but only teaches how to screen for the claimed polypeptides, and since detailed information regarding the structural and functional requirements of the polypeptides are lacking, it is unpredictable as to which variations, if any, meet the limitations of the claims. Thus, since Applicant has only taught how to test for nucleic acids encoding polypeptide variants of AMPA Receptor, and has not taught how to make nucleic acids encoding polypeptide variants of AMPA Receptor, it would require undue experimentation of one of skill in the art to make and use the claimed polynucleotides.

Applicant has added the limitation wherein the nucleic acid encodes a polypeptide at least 70% identical to SEQ ID NO: 7, and added the limitation wherein the encoded polypeptide functions as a non-desensitizing AMPA-receptor. However, in the instant case there are a large number of peptide species which are at least 70% identical to SEQ ID NO: 7, and the specification does not disclose the critical residues necessary to maintain function. The specification does not disclose the correlation between the structure (sequence) of the polypeptides and the function as a non-desensitizing AMPA-receptor. The amino acid sequence of a polypeptide determines its structural and functional properties, and predictability of which amino acids can be substituted is extremely complex and well outside the realm of routine experimentation, because accurate predictions of a polypeptide's structure from mere sequence data are limited. Since detailed information regarding the structural and functional requirements of the peptides are lacking, it is unpredictable as to which encoding variations, if any, meet the

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limitations of the claims. Therefore it would require undue experimentation by one of skill in the art to make and use the invention as claimed without further guidance from the instant specification.

Claims 1-17, 21-23, 34-35, 37 are rejected, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

The claims are drawn to a complement of a nucleic acid which hybridizes to a nucleic acid encoding SEQ ID NO: 7; or a nucleic acid which encodes SEQ ID NO: 7 and further comprising amino acid additions substitutions or deletions; or a nucleic acid which encodes an AMPA-type receptor and further comprising amino acid additions substitutions or deletions and are thus genus claims. The specification and claim do not indicate what distinguishing attributes shared by the members of the genus. The specification and claims do not place any limit on the number of amino acid substitutions, deletions, insertions and/or additions that may be made to the encoded AMPA Receptor variants. Thus, the scope of the claim includes numerous structural variants, and the genus is highly variant because a significant number of structural differences

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between genus members is permitted. The specification and claim do not provide any guidance as to what changes should be made. Structural features that could distinguish compounds in the genus from others in the nucleic acid class are missing from the disclosure. No common structural attributes identify the members of the genus. The general knowledge and level of skill in the art do not supplement the omitted description because specific, not general, guidance is what is needed. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, SEQ ID NO: 17 encoding SEQ ID NO: 7 is insufficient to describe the genus. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant identifying characteristics, i.e. structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between structure and function structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. In the instant case, the specification fails to provide sufficient descriptive information, such as definitive structural or functional features of the genus of polynucleotides. There is no description of the conserved regions which are critical to the structure and function of the genus claimed. There is no description of the sites at which variability may be tolerated and there is no information regarding the relation of structure to function. Furthermore, the prior art does not provide compensatory structural or correlative teachings sufficient to enable one of skill to isolate and identify the polynucleotides and polypeptides encompassed. Thus, no identifying characteristics or properties of the instant polypeptides are provided such that one of skill would be able to

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predictably identify the encompassed molecules as being identical to those instantly claimed.

One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the genus. Thus, applicant was not in possession of the claimed genus.

Applicant has added the limitation wherein the nucleic acid encodes a polypeptide at least 70% identical to SEQ ID NO: 7, and added the limitation wherein the encoded polypeptide functions as a non-desensitizing AMPA-receptor. However, the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant identifying characteristics, i.e. structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between structure and function structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. In the instant case, the specification fails to provide sufficient descriptive information, such as definitive structural or functional features of the claimed genus of polypeptides. There is no description of the conserved regions which are critical to the structure and function of the genus claimed. There is no description of the sites at which variability may be tolerated and there is no information regarding the relation of structure to function. Structural features that could distinguish the compounds in the genus from other seven transmembrane region compounds are missing from the disclosure. Furthermore, the prior art does not provide compensatory structural or correlative teachings sufficient to enable one of skill to isolate and identify the polypeptides encompassed: there is no guidance in the art as to what the defining characteristics of the peptides might be. Thus, no identifying characteristics or

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properties of the instant polynucleotides are provided such that one of skill would be able to predictably identify the encompassed molecules as being identical to those instantly claimed.

Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, the disclosure of SEQ ID NO: 7 is insufficient to describe the genus. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe and enable the genus as broadly claimed.

***Claim Rejections - 35 USC § 112 second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is indefinite in the recitation of the term "derived from". It is unclear whether this term imposes a required limitation on the claim, such that it only encompasses, for example, polynucleotides amplified from human cDNA, or only sequences produced by digestion with restriction enzymes of DNA isolated from human tissue that contains polynucleotides encoding the receptor, or if the claim encompasses all polynucleotide sequences that encode the receptor. Therefore, the metes and bounds of the claim are unclear. Applicant argues that the claim has been amended to reflect that the polypeptide is "derived from" a human. However, it is still not clear how it is to be determined whether the polypeptide is to be considered "derived from" a human. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of

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ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph "by providing clear warning to others as to what constitutes infringement of the patent". See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). MPEP 2173.02, MPEP 2173.02. In the instant case, there is no criteria by which one of ordinary skill could determine whether a polypeptide falls within the metes and bounds of polypeptides which are to be considered "derived from" a human.

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

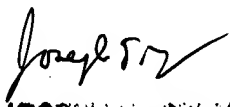
***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Murphy whose telephone number is (571) 272-0877. The examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (571) 272-0829.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph F. Murphy, Ph. D.  
Primary Examiner  
Art Unit 1646  
July 25, 2005

  
**JOSEPH MURPHY**  
**PATENT EXAMINER**